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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/726,030    10/04/96    CISAR    J    TELNP0120US

PM21/0721

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EXAMINER

LOUIS JACQUES, J

ART UNIT

PAPER NUMBER

3614

DATE MAILED:

07/21/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

*See attached.*

# Office Action Summary

Application No.  
**08/726,030**

Applicant(s)  
**James M. Cisar**

Examiner  
**Jacques H. Louis-Jacques**

Group Art Unit  
**3614**



☒ Responsive to communication(s) filed on Jun 1, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8 and 10-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 14-17 is/are allowed.

☒ Claim(s) 1-8, 10-13, and 18-28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892 ✓

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This office action is responsive to communication filed on June 1, 1998.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, 10-13, 18-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith, III et al [4,359,222].

Smith, III et al discloses a hand-held electronic [game playing] device [with replaceable cartridges] having a flat panel [electro-optical] display unit incorporated in a housing. Circuit suitable for driving the display unit and manually operable controls for providing a plurality of control functions are incorporated in the housing. There is also discloses a microprocessor or processor which defines the program of functions to be performed. In the drawings there is shown a "wheel thumb" (94) for selecting one of the plurality of functions to be performed by the processor. The microprocessor transmits appropriate signals to the circuitry to cause a predetermined visual symbol to appear on the display unit. The use of a "wheel thumb" in the claims of the present application instead of the control knob 94 of Smith, III et al is a matter of design choice as both the "wheel thumb" and the "control knob" preform the same functions, i.e. selecting one of a plurality of functions to be performed or executed by the microprocessor. See

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In re Japikse , 181 F.2d 1019, 86 USPQ 70; In re Kuhle , 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

4. Claims 1-8, 10-13, 18-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Loizeaux [4,993,004].

Loizeaux discloses a passively activated lap counter and timer. The device includes a housing, a user programmable processor with the housing, a display coupled to the processor, a thumb control or mode selection button for selecting different functions for the device and a control circuitry coupled to the control button for providing signals to the processor. The use of a “wheel thumb” in the claims of the present application instead of the “selection button” of Loizeaux is a matter of design choice as both the “wheel thumb” and the “selection button” perform the same functions, i.e. selecting one of a plurality of functions to be performed or executed by the microprocessor. See In re Japikse , 181 F.2d 1019, 86 USPQ 70; In re Kuhle , 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

***Allowable Subject Matter***

5. Claims 14-17 are allowed.

***Response to Amendment & Arguments***

6. The amendments and arguments filed therewith have been entered and carefully considered by the examiner.

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Applicant has amended the claims to emphasize that the mobile device is a hand held” mobile device comprising, in addition to other components, a display connected to the processor, and the thumb wheel includes a “wheel portion rotatable about an axis to facilitate a user section of one of the plurality of functions”.

Applicant also amended that the claims by replacing the “bar code reader” feature with the directions (clockwise and counterclockwise) of the wheel portion.

The first and main point of argument raised by applicant is that the prior art references to Kull and Jowers et al do not teach a mobile device which can be operated with one hand by a user, i.e., “the user can hold the mobile device in one hand and use the thumb wheel to interact with the mobile device with the same hand.”

Notwithstanding the arguments raised regarding the prior art references, the rejection using the Kull and Jowers et al references has been withdrawn. Necessitated by the amendments, the examiner has applied a new ground of rejection against the claims. Accordingly, this office action is made final.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a.	4,627,277	Baer	Dec. 1986
b.	4,650,161	Kaneko	Mar. 1987

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c.	4,685,065	Braun et al	Aug. 1987
d.	5,648,897	Johnson et al	Jul. 1997
e.	5,684,861	Lewis et al	Nov. 1997

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jacques H. Louis-Jacques** whose telephone number is (703) 305-9757.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Group Receptionist** whose telephone number is (703) 308-1113.

10. Any response to this action should be mailed to:

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**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

**(703) 305-7687**, (for formal communications intended for entry, please indicate as so; and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Second Floor (Receptionist).

/jlj  
July 7, 1998

*Jacques*  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER